

Docket No. F-8698

Ser. No. 10/550,126

REMARKS

Claims 23, 26-30, 35-37, 39-43, and 48-69 are now pending in this application. Claims 23-48 are rejected. Claim 30 is objected to. Claims 24, 25, 31-34, 38, and 44-47 are cancelled herein. Claims 1-22 are previously cancelled. New claims 49-69 are added. Claims are amended herein to overcome the rejections set forth based upon results of an interview discussed below. The amendments do not make substantive changes to the claims but merely combine dependent claims to stand in independent form. Other formal matters, including adjusting the computer-readable medium claims to positively recited "executable form," are attended to that were not addressed by the Examiner and accordingly are considered unrelated to substantive patentability issues.

INTERVIEW ACKNOWLEDGMENT

The applicant and applicant's attorney appreciate the Examiner's granting of the telephone interview conducted on August 6, 2009, and extend their thanks to the Examiner and Supervisor Steve Sax for their time and consideration. During the interview claims 25-28, and 38-41 were discussed. In particular, claim 25 was used as an example, and has subject matter similar to the remaining claims in that a same button as previously operated in the independent claim is referred to as "the activated operating section corresponds to the currently opened window" since such an activating section would have had to have been previously operated to have the

Docket No. F-8698

Ser. No. 10/550,126

“currently opened window” opened. Each of the remaining noted claims includes such subject matter.

It was explained that each of the claims is directed to a situation when the *activated operating section corresponds to the presently opened window* and requires that a certain function be performed in response to the activation of the section. It was further called to the Examiner’s attention that the rejection of independent claim 23 interprets operating sections, corresponding to windows, as prior, current, and next windows (pg. 5) which have corresponding buttons 1, 2 and 5. See OA pg 3. paragraph c. While applicants do not necessarily agree with the Examiner’s interpretation of “corresponding” in relation to the “window” item, it is the Examiner’s interpretation that is used and related in this traverse.

With regard to each of the noted claims, 25-28, and 38-41, the rejection cites buttons used by Opera, i.e., buttons 3, F2, F4 and an unknown button for “Access active bookmark folder,” to effect a function listed which the Examiner considers to correspond to a function of the given claim. None of the buttons cited in the rejection of the noted dependent claims, 25-28, and 38-41, i.e., buttons 3, F2, F4 and an unknown button, corresponds to any of the Opera buttons *relied on by the Examiner* in the rejection of independent claim 23, i.e., Opera buttons 1, 2 and 5, as an activated operating section that *corresponds to the presently opened window*. Hence, it is submitted that the anticipation rejections are inconsistent and thus do not set forth a *prima facie* case of anticipation.

Docket No. F-8698

Ser. No. 10/550,126

Agreement was reached that the rejections set forth were not consistent and hence that the rejections cannot be sustained because none of the buttons cited in the rejections in the noted dependent claims corresponds to any of buttons 1, 2 and 5 chosen as the buttons that might correspond to the "operating section" which corresponds to a "currently opened window" in the rejection of the independent claims.

It was further discussed that proposed claim amendments would be presented regarding the independent claim 23 subject matter. At present, applicants have chosen to rely upon the subject matters discussed above and found in dependent claims 25-28, and 38-41.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)

Claims 23-48 are rejected under 35 U.S.C. § 102(b) as being anticipated again by the Opera reference. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). It is respectfully submitted that the cited reference is deficient with regard to the following.

With regard to the independent claims 23 and 37, the Examiner is loosely interpreting the language "corresponding" regarding the operating sections corresponding to the windows. Applicants maintain that the corresponding language

Docket No. F-8698

Ser. No. 10/550,126

requires the same window with like content as previously displayed for that window be displayed when the corresponding operating section is activated. Nonetheless, in view of the agreement reached during the interview, each of the now independent claims recites subject matter of one of claims 25-28, and 38-41, with regard to which agreement was reached that the anticipation rejection as set forth is inconsistent. The correspondence of the claims is set forth below.

The subject matter of claim 25 is now incorporated into claim 23, and claims 26-28 are made independent. Dependent claims 49-63 are added to depend from respective ones of claims 26-28 and reflect subject matter of claims 29, 30, 35, 36 and 48. The subject matter of claim 38 is now incorporated into claim 37, and claims 39-41 are made independent. Dependent claims 64-69 are added to depend from respective ones of claims 39-41 and reflect subject matter of claims 42 and 43.

In view of the above, it is respectfully submitted that claims 23, 26-30, 35-37, 39-43, and 48-69 particularly describe and distinctly claim elements not disclosed in the cited reference. Therefore, reconsideration of the rejections of claims 23, 26-30, 35-37, 39-43, and 48-69 and their allowance are respectfully requested.

NEXT ACTION CANNOT BE MADE FINAL

It is further noted that the above discussed features of claims 25-28 and 38-41 were present in the filed claims prior to present amendment. As such, the

Docket No. F-8698

Ser. No. 10/550,126

present amendments cannot necessitate new grounds for rejection as the present rejections are respectfully submitted as failing to have been established.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP 8th ed., rev. 7, §706.07(a) *Final Rejection, When Proper on Second Action.*

The terminology "necessitated by applicant's amendment" refers to amendments changing substance and not form. Since claims 23, 26-28, 37, and 39-41 as presently set forth contain no amendments changing substance that would necessitate new grounds because their subject is identical to that of prior pending claims 25-28 and 38-41, and the grounds of rejections of those prior pending claims is submitted as having been overcome by the above arguments and agreement reached in the interview, any new grounds of rejection set forth in relation to the noted claims cannot have been necessitated by present amendments.

Additionally, amendments of other claims and or the addition of new claims cannot be the basis for making the next action final since the rejection of the aforementioned claim(s) is overcome without substantive amendments. The MPEP clearly sets this forth as follows:

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, ... of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

RECEIVED
CENTRAL FAX CENTER

SEP 10 2009

Docket No. F-8698

Ser. No. 10/550,126

MPEP 8th ed., rev. 7, §706.07(a) *Final Rejection, When Proper on Second Action.*

Accordingly, it is respectfully submitted that a next Office Action cannot be made final.

CLAIM FEES

This application was filed September 19, 2005, with 22 claims and 4 independent claims, and 2 claims over twenty and 1 independent claim over twenty were paid for at that time. The Amendment filed November 18, 2008, paid for 4 further claims over twenty. Hence, in total, 1 independent claim over three, and 6 claims over twenty have been paid for in this application.

The application now contains in total 36 claims of which 8 are independent. Thus, ten (10) further claims in excess of twenty are added and four (4) further independent claims in excess of three are added. The fee of \$1400 for the claims is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

REQUEST FOR EXTENSION OF TIME

Applicants respectfully requests one month extension of time for responding to the Office Action. The fee of \$130.00 for the extension is provided for in the

09/15/2009 LLANDGRA 00000007 10550126

01 FC:1615 520.00 OP
02 FC:1614 880.00 OP

23

F8698 em03 filed (PC10) wpd

09/15/2009 LLANDGRA 00000007 10550126

03 FC:1251 130.00 OP

Docket No. F-8698

Ser. No. 10/550,126

charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

by and,

By H. F. Ruschmann
Herbert F. Ruschmann
Reg. No. 35,341
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

enc: Form PTO-2038.